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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,709	04/10/2001	David L. Anglin	08935-240001 / M-4931A	1782

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EXAMINER
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MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/829,709

Applicant(s)

ANGLIN, DAVID L.

Examiner

Julian Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-31,33-36,39-41 and 43-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-31,33-36,39-41 and 43-56 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Remarks***

This Office action is responsive to applicant's amendment filed November 25, 2005.

Claims 1, 8-31, 33-36, 39-41 and 43-56 are pending.

This Office action is made Non-Final.

### ***Claim Objections***

Claim 16 is objected to because of the following informalities:

1. In claim 16, it is suggested to change "the carbon fibers have been heat treated" to --the carbon fibers are heat-treated carbon fibers--, in order to give this claim a more proper structural limitation. See claim 35, which recites the heat-treated carbon fibers in this manner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-10, 19, 30, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend (EP 0 962 997 A1) in view of Adams (U.S. Pat. 4,177,157).

This rejection is maintained for the reasons of record.

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Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Andersen (U.S. Pat. 4,948,484).

This rejection is maintained for the reasons of record.

Claims 13-18, 20-22, 35, 36, 39-41, 43-48, 50 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Andersen, and further in view of Yagi (U.S. Pat. 4,923,637).

This rejection is set forth for the reasons of record and for the detailed reasons set forth in the Office action sent December 2, 2003 pages 3-5. A reiteration here follows: while Friend does not explicitly teach the claimed average diameter or average length of heat-treated carbon fibers, the skilled artisan would find obvious to further modify Friend's invention by employing the heat-treated carbon fibers of Yagi in order to achieve high conductivity and dispersability into the applied resin. See Yagi in col. 2 line 25 et seq.

Claims 23 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Lafdi and Wright. (Carbon Fibers from Handbook of Composites, 1998)

This rejection is maintained for the reasons set forth above and for the reasons of record.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Singer (U.S. Pat. 4,005,183)

This rejection is maintained for the reasons of record.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Singer (U.S. Pat. 4,005,183)

This rejection is maintained for the reasons set forth above and for the reasons of record.

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Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Lafdi, Wright and Singer.

This rejection is maintained for the reasons of record.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Glasgow et al. (U.S. Pat. 6,506,355)

This rejection is maintained for the reasons of record.

Claims 50 and 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Glasgow et al.

This rejection is maintained for the reasons set forth above and for the reasons of record.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Mototani et al. (U.S. Pat. 5, 482,798)

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Mototani et al.

This rejection is maintained for the reasons set forth above and for the reasons of record.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams, and further in view of Chalilpoyil et al. (U.S. Pat. 4,777,100)

This rejection is maintained for the reasons of record.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Chalilpoyil et al.

This rejection is maintained for the reasons set forth above and for the reasons of record.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Chalilpoyil et al., and further in view of Callahan et al. (U.S. Pat. 6,287,730 B1)

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This rejection is maintained for the reasons of record.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend in view of Adams and Yagi, and further in view of Callahan et al. (U.S. Pat. 6,287,730 B1)

This rejection is maintained for the reasons set forth above and for the reasons of record.

The above rejections are maintained for the reasons of record. The examiner notes the present amendment to independent claim 1 now reciting the amount of carbon fibers at about 6% to about 7% by weight. However, absent of unexpected results it is asserted that this is an optimizable parameter for a result-effective variable. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) The amount thereof is maintained result-effective for reasons made of record and for the reasons specifically taught by the prior art, such as enhancing the level of conductivity of the electrode. Applicant's disclosure has been fully reviewed but is found silent on any criticality or unexpected results for the claimed range of about 6% to about 7% by weight of carbon fibers. The prior art presently relied upon is also not found to materially teach away from the claimed invention in any respect.

Arguments for claims 31 and 35 have been fully considered, however they are not found persuasive. Applicant's observation that the ranges in each of the references relied upon do not overlap does not preclude the combination of the references to teach or at least suggest the claimed invention. As to an alleged loss of capacity or no improved performance characteristics from the combined teachings, applicant is reminded that attorney arguments are not evidence and cannot take place of evidence in the record and are not the kind of factual evidence that is required to rebut a prima facie case of obviousness. MPEP 2145. In response to applicant's

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argument that nickel hydroxide electrodes is not combinable with magnesium oxide electrodes, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, each of the references relied upon for the combination is considered to satisfy both situations.

Arguments with respect to the carbon fibers in Friend and Adams referring only to the formation of the carbon fibers and not to a subsequent, post-manufacture heat treatment have been fully considered. In order to more properly set forth a teaching of the prior art towards this claimed feature, claims 16-18, 35, 43 and 44 are now presently rejected based on based on Friend, Adams, and Yagi. While the examiner concedes that Friend does not explicitly teach heat-treated carbon fibers, and that arguably the heat treatment in Friend is applied during manufacture and not post-treatment of the formed carbon fiber, heat-treated carbon fibers would have been obvious to the skilled artisan in order to develop and stabilize the plane and crystal arrangement of the fiber. See Yagi in col. 4 line 12 et seq.

Arguments against Callahan have been fully considered, however these arguments are not persuasive. Callahan is maintained to teach or at least suggest EVOH, and while applicant appears to categorize EVOH as an admixture to a surfactant, nonetheless the disclosed EVOH is maintained readable on the claimed surfactant by virtue of it being *the same* compound called for by claims 29 and 55. EVOH is ethylene-vinyl alcohol, which is readable (quite literally) on the claimed "ethylene-vinyl alcohol." A rose is a rose is a rose; a thing is what it is and not so much what it is called. See, for example, Shakespeare, *Romeo and Juliet*, Act II, Scene II.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to be 'Julian', with a large, stylized loop at the end.A handwritten signature in black ink, appearing to be 'Patrick J. Ryan', with a stylized 'P' and 'R'.

**PATRICK JOSEPH RYAN  
SUPERVISORY PATENT EXAMINER**